Remarks

Request for continued examination

The Applicants hereby request continued examination of the instant application (serial no. 09/687,794) under 37 CFR 1.114.

Amendments to the claims/new claims

Original claims 1-21 have been cancelled and have been replaced with generally corresponding new claims 22-42. (That is, for example, new claim 22 generally corresponds to original claim 1, new claim 23 generally corresponds to original claim 2, and so on.) Support for amendments to the new claims over the original claims is found in the specification at page 7 lines 6-21.

The new claims are not being presented to overcome the prior art, but are instead being presented for the following reasons: (1) to more clearly set forth the originally claimed invention; and (2) to replace certain terms in the original claims with more precise terms found in the detailed description to thus facilitate understanding of the differences between the invention and the prior art.

Rejection of Claims under 35 U.S.C. § 112

Claims 1, 9, 18 and 21 have been rejected under 35 U.S.C. § 112 since the term "the command" is not supported by the specification.

Claims 1, 9, 18 and 21 have been cancelled. In the new claims, the term "the command" has generally been replaced with the term "Broken Image Tracking ('BIT') tag", as found in the specification at page 7, line 7. The Applicants contend that the new claims are therefore definite.

(Continued on next page.)

Rejection of Claims under 35 U.S.C. § 102

Original claims 1-5, 8-9, 12, 14-17 and 21 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,466,966 B1 ("Kirsch").

Claims 1-5, 8-9, 12, 14-17 and 21 have been cancelled, and therefore the rejection of those claims is now moot. Further, the Applicants contend that new claims 22-26, 29-30, 33, 35-38 and 42 (generally corresponding respectively to original claims 1-5, 8-9, 12, 14-17 and 21) are not anticipated by Kirsch.

As a starting point, the PTO and the Federal Circuit provide that §102 anticipation requires each and every element of the claimed invention to be disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. (*Kloster Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986)). Furthermore, "[a]nticipation requires that all of the elements and limitations of the claims are found within a single prior art reference." (*Scripps Clinic and Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991 (emphasis added)). Moreover, the PTO and the Federal Circuit provide that §102 anticipation requires that there must be no difference between the claimed invention and the reference disclosure. (*Scripps Clinic and Research Found. v. Genetech, Inc.*, id. (emphasis added)). Accordingly, if the Applicants can demonstrate that any one element or limitation in claims 22-26, 29-30, 33, 35-38 and 42 is not disclosed by Kirsch, then the respective claim(s) must be allowed.

In the following arguments, the Applicants will focus in particular on independent claims 22, 30 and 42, as the Applicants believe those claims to be allowable (as newly presented above) over Kirsch. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable, and

therefore the Applicants do not believe it is necessary to present arguments in favor of each and every dependent claim.

Claim 22

The Applicants contend that new claim 22, and claims 23-29 which depend therefrom, are not anticipated by Kirsch.

Claim 22 includes the following limitations:

A method for tracking the use of a web tool by a web user, comprising, <u>sequentially</u>:

providing a web user through a web user computer access to a web tool;

in response to the user accessing the web tool, inserting within at least one or more web page files a Broken Image Tracking ("BIT") tag that includes user information associated with the web user's use of the web tool and a BIT URL designating a server;

transmitting from the web tool to the web user computer the one or more web page files, <u>wherein the one or more web page files are configured to be **displayed to the user**</u>, and the one or more web page files and the BIT tag are configured to be executed by the user computer and, as a result, <u>the user information is transmitted from the user computer directly to the designated server</u>; and

storing the user information in a database identified by the designated server.

(Emphasis added.)

A careful reading of Kirsch at column 7 lines 6-23 reveals the differences between what is disclosed by Kirsch and what is claimed by the Applicants. Specifically, in Applicants claim 22, the web page sent to the web user's computer by the web tool includes the content to be displayed to the web user, as well as the user information that is to be stored to track the use of the web tool by the web user. This is in contrast to what is described by Kirsch. In Kirsch, the accounting information (generally corresponding to Applicants' "user information") is transmitted in a separate transmission from the web page to be displayed to the user, and the web page to be displayed to the user is transmitted to the user separately as a result of the "redirect" in the earlier transmission. That is, the desired web page selected by the user in Kirsch is only displayed to the user as a result of the redirect (and not as a result of the initial selection of the hyperlink), and after the user information has been stored. (See Figs. 3 and 4 of Kirsch.) This is in further contrast to what is claimed by the Applicants' in claim 22, wherein the web page is displayed to the user before the user information is stored.

Further, the Applicants contend that the "Broken Image Tracking" tag and the "BIT URL" of claim 22 are not taught by Kirsch. Kirsch does not recite any component that will cause an error message to be generated as a result of processing the component, whereas a BIT URL *specifically* causes an error message to be generated.

For at least these reasons, the Applicants contend that new claim 22, and claims 23-29 which depend therefrom, are not anticipated by Kirsch.

Moreover, with particular respect to Applicants' claim 26, nothing in Kirsch teaches or suggests storing the user information ("accounting data" of Kirsch) in an error log. Kirsch only describes storing accounting data in a "tracking server" (Col. 5, lines 23-25).

The Applicants therefore request that claims 22-29 be allowed.

<u>Claim 30</u>

The Applicants contend that new claim 30, and claims 31-39 which depend therefrom, are not anticipated by Kirsch. With respect to independent claim 30, that claim includes the following limitations:

A system for tracking web users' use of a web tool, comprising:

a web tool server . . . configured to insert within at least one of the web page files associated with the session a BIT tag including a BIT URL and embedded user information associated with the web user's use of the web tool, and wherein:

the web tool is configured to provide the at least one web page to the web user computer **to be displayed by the web user computer**; and

the at least one web page and the BIT tag are configured to be *executed* by the web user computer *after* the web page has been received by the user computer; and

. . . wherein the web page file and the BIT tag, *when executed by the web user computer*, cause the web user computer to transmit to the designated server <u>the user information</u>, and further wherein the designated server is configured to store the user information in a database.

(Emphasis added.)

As can be seen, the system of Applicants' claim 30 is configured such that the web page to be displayed to the user is transmitted to the user not only includes the "user information" to be stored but also the content to be displayed to the web user. Further, the web page is displayed to the web user, *after which* the user information

is stored on the designated server. As described above with respect to claim 22, the system of Kirsch is different in that (1) the "accounting information" is transmitted separately from the content to be displayed to the user; and (2) the "accounting information" is first stored, *after which* the redirect sends the requested web page to the user for displaying. As also described above with respect to claim 22, the Applicants contend that Kirsch does not teach the use of Broken Image Tracking tags or BIT URLs, as no "error message" is generated as a result of processing any message component described in Kirsch.

For at least these reasons, the Applicants contend that claim 30, and claims 31-38 which depend therefrom, are not anticipated by Kirsch.

Claim 42

The Applicants contend that new claim 42 is not anticipated by Kirsch. Claim 42 includes the following limitations:

A computer program product . . . to perform the following sequential acts:

provide a web user through a web user computer access to a web tool;

in response to the user accessing the web tool, insert within at least one or more web page files, using the web tool, a Broken Image Tracking ("BIT") tag including a BIT URL and embedded user information associated with the web user's use of the web tool; and

transmit from the web tool to the web user computer the one or more web page files; and

wherein, upon receipt of the web page file by the web user computer:

the one or more web page files are configured to be **displayed by the user computer**; and

the one or more web page files and the BIT tag are configured to be **executed by the user computer** upon receipt of the web page file by the web user computer;

the web page file is configured such that, upon execution of the web page file and the BIT tag by the web user computer, the BIT URL is transmitted to a designated server; and

the BIT URL is configured such that, in response to the BIT URL being processed by the designated server, the user information is stored in a database. (Emphasis added.)

Similar to claims 22 and 30 discussed above, the computer program product of claim 42 is configured to transmit a web page to a user computer, wherein (1) the web page is configured to be displayed by the user computer, and (2) the web page includes the user information to be stored in a database. Further, the computer program product of claim 42 is configured to first transmit the web page to the user computer to be displayed, after which the user information is routed to, and saved in, a designated server. This is in contrast to what is described by Kirsch, wherein (1) the "accounting information" to be stored is sent in a first message, and the web content to be displayed to the user is sent in a second message (as a result of a "redirect" in the first message); and (2) "accounting information" is first saved, after which the web page selected by the user is displayed to the user as a result of the redirect. Additionally, the Applicants contend that the "Broken Image Tracking" tag and the "BIT URL" of claim 42 are not taught by Kirsch. Kirsch does not recite any component that will cause an error message to be generated as a result of

processing the component, whereas a BIT URL specifically causes an error message to be generated.

For at least these reasons, the Applicants contend that new claim 42 is not anticipated by Kirsch.

For all of the reasons stated above, the Applicants contend that none of new claims 22-42 are anticipated by Kirsch. The Applicants therefore request that these claims be allowed.

Rejection of Claims under 35 U.S.C. § 103(a)

Original claims 6, 7, 10, 11, 13 and 18-20 were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,466,966 B1 ("Kirsch") in view of Morimoto et al (US 6,397,244) ("Morimoto").

Claims 6, 7, 10, 11, 13 and 18-20 have been cancelled, and therefore the rejection of those claims is now moot. Further, the Applicants contend that new claims 27, 28, 31, 32, 34 and 39-41 (generally corresponding respectively to original claims 6, 7, 10, 11, 13 and 18-20) are not obvious over Kirsch in view of Morimoto.

As a starting point, MPEP 706.02(j) states:

"[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, <u>there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings</u>. Second, there must be a reasonable expectation of success. Finally, <u>the prior art reference</u> (or references when combined) <u>**must** teach or suggest</u> <u>**all** the claim limitations</u>. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must

both be found in the prior art and not based on applicant's disclosure."
(Emphasis added.)

With respect to new claims 27 and 28, those claims depend from new claim 22. With respect to new claims 31, 32 and 34, those claims depend from new claim 30. For the reasons stated above, the Applicants contend that new claims 22 and 30 are allowable. It is axiomatic that any claim which depends from an allowable claim is also allowable. Accordingly, claims 27, 28, 31, 32 and 34 are also allowable since they inherently include the limitations of claim 22 (for claims 27 and 28) and claim 30 (for claims 31, 32 and 34).

Further, Kirsch does not teach or suggest using an error log to capture user information, as is required by each of Applicants' claims 27, 28, 31, 32 and 34. Although Morimoto describes the use of an error log, the Applicants contend that there is no motivation to combine Kirsch and Morimoto. Specifically, Kirsch teaches a method and apparatus for tracking use of hyperlinks. Such a reference might be relevant to the Applicants' claims, since the Applicants' claims are directed towards methods and apparatus for tracking the use of web tools. There is nothing in Kirsch remotely suggestive of tracking errors. By like token, there is nothing in Morimoto remotely suggestive of tracking a web user's use of a web tool, or tracking use of hyperlinks. Morimoto is directly <u>only</u> to error tracking. Accordingly, one looking at methods and apparatus for tracking a web user's use of a web tool would <u>not</u> consider Morimoto. The Applicants' respectfully contend that the only reason Morimoto was cited was because the Examiner impermissibly used the Applicants' claims as a roadmap to identify the Morimoto reference. Otherwise, there would have been no incentive to select the Morimoto reference.

For at least these reasons the Applicants contend that claims 27, 28, 31, 32 and 34 are not obvious over Kirsch in view of Morimoto.

With respect to new claims 39-41, independent claim 39 (and thus, inherently, dependent claims 40-41) include the following limitations:

A web tool system having a capability of tracking a user's use of a web tool, comprising:

a web tool server . . . including a web tool program configured to generate and provide to the web user computer one or more web page files in connection with the web user engaging in a session with the web tool, the web tool server further being configured to include in the one or more web page files a <u>BIT tag</u> including a BIT URL and embedded user information associated with the web user's use of the web tool, and wherein:

<u>the at least one web page file and the BIT tag are configured to be executed by the user computer after the web page has been received by the web user computer; and</u>

<u>*the at least one web page file is configured to be displayed by the*</u> <u>*web user computer,*</u> and

a designated server identified in the BIT URL and communicatively linked to the web user computer, the designated server including a web server with an error log; and

a user information database server communicatively linked to the designated server, wherein the designated server is configured to transfer the user information from the BIT URL to the user information database in response to processing the BIT URL.

(Emphasis added.)

As can be seen, in the web tool system of Applicants' claim 39, the web page that includes the user information is also the web page that is configured to be displayed on the web user's computer. As variously described above, this is in contrast to what is described by Kirsch. Specifically, in Kirsch the web file that includes the "accounting information" (generally equivalent to Applicants' "user information") is transmitted to the web user's computer separately from the web content page, and the web content page is only transmitted to the user computer as a result of a redirect included in the original web page. That is, in Kirsch the web page content intended to be displayed to the user is <u>not</u> part of the web page that includes the user information to be recorded, as is required by Applicants' claim 39.

Accordingly, since Applicants' claim 39 recites at least one element neither taught nor suggested by Kirsch or Morimoto, there can be no § 103 obviousness of Applicants' claim 39. For at least this reason, the Applicants contend that claim 39 is allowable over Kirsch and Morimoto.

With respect to claim 40, beyond the lack of motivation to combine Kirsch and Morimoto (as described above with respect to claims 27 etc.), neither Kirsch nor Morimoto teach or suggest causing a server to generate a broken image error for purposes of tracking <u>user information</u>. The error recording system of Morimoto is for the purpose or recoding <u>unintentional errors</u> (which inherently occur only when an unintentional error arises), and **not** for the purposes of tracking user information <u>regardless</u> of whether an unintentional error arises or not (as is inherently required by Applicants' claim 40).

For at least these reasons, the Applicants contend that new claim 39, and claims 40-41 which depend therefrom, are not obvious over Kirsch in view of Morimoto.

For at least all of reasons stated above, the Applicants contend that none of new claims 22-42 are obvious over Kirsch in view of Morimoto, and therefore respectfully request timely allowance of these claims.
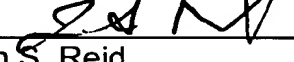
Summary

The Applicants believe that this response constitutes a full and complete response to the Office action, and therefore request timely allowance of claims 22 through 42.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,

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Date: January 10, 2004   By _____

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